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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

32808

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Robert F. Bodi

Application Number

09/616,652

Filed

July 14, 2000

First Named Inventor

Osamu Sasaki et al.

Art Unit

3621

Examiner

Pierre E. Elisca

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

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applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent acting under 37 CFR 1.34.

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12/1/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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PRE-APPEAL BRIEF CONFERENCE REMARKS

These remarks/arguments are filed along with a Notice of Appeal and a Pre-Appeal Brief Request for Review in response to the Office Action dated July 5, 2005. Applicant's representative would like to thank the Examiner for the personal interview conducted on November 1, 2005, where potential claim amendments were discussed. However, after consultations with the applicant, it has been determined that the current claims are not taught by the cited references, and thus that claim amendments are not justified at this time.

Claims 1-56 stand rejected as being unpatentable over Hiroya *et al.* (U.S. 5,754,654) and Sasmazel *et al.* (U.S. 6,032,260) in view of Cogger *et al.* (U.S. 6,032,184).

As discussed in the response to these rejections filed on October 4, 2005 (see pages 2-3), Claim 38 recites an electronic ticket processing system comprising a networked-linked electronic ticket including both an "electronic ticket" and a "network electronic ticket" different from the electronic ticket. The "electronic ticket" is specifically recited in clear claim language as being for "providing a customer access to a commodity or a service" or "user admission to an event" whereas the "network electronic ticket" is specifically recited in clear claim language as being for "providing the customer access to access limited online information about the commodity or service or the event from an information providing apparatus on a network." Independent claims 39 and 43 also recite similar limitations, all including both an electronic ticket and a network electronic ticket similarly defined as in claim 38.

Thus, these claims clearly recite that the networked-linked electronic is comprised of two different elements (an electronic ticket and a network electronic ticket) each having specifically defined and different purposes. The references, even if combined, do not teach both of these elements of the claim as limited by the explicit claim language.

Although the Examiner cites Hiroya as substantially teaching the electronic ticket and network electronic ticket, he fails to point out where the reference supposedly teaches both of these elements, and in fact, the Examiner later admits that Hiroya "fails to explicitly disclose that the network electronic ticket different (sic) from the electronic ticket" (see Office action of July 5, 2005, on the first full paragraph of page 3). In reality, Hiroya arguably appears to teach only a single electronic ticket used to replace a paper ticket, such as for providing access to a train or concert (see Background and Summary sections). There appears to be no suggestion of anything

similar to the “network electronic ticket” of the claims, and thus the Examiner is correct that Hiroya fails to teach the network electronic ticket as recited in the claims.

The Examiner specifically cites an encrypted “hash number” taught by Sasmazel as teaching the “network electronic ticket” of claim 38, but the Examiner fails to show where the reference teaches that this hash number provides “the customer access to access limited online information about the commodity or service or the event from an information providing apparatus on a network.” A close review of the reference confirms that, in fact, there is no such teaching.

Instead, the Examiner merely says that this hash number is “different” from the electronic ticket of the reference. But the claim language clearly and unambiguously requires far more than just that the electronic ticket be *different* from the network electronic ticket, the “network electronic ticket” must also be for “providing the customer access to online information about the commodity or service or the event from an information providing apparatus on a network.” It is not enough to just provide information, the claim language clearly requires that the information be *about the commodity or service or event being accessed by the use of the electronic ticket*. The two items are explicitly related in the manner defined by the claims.

Nevertheless, the Examiner just ignores these clear claim limitations. In fact, Sasmazel does not discuss any commodity, service, or event purchase at all, and thus it clearly cannot teach providing access to information *about* the commodity, service, or event that it is silent about. Instead, the ticket of Sasmazel appears to be used for authentication purposes, such as authenticating a website (see Background and Summary sections of the reference) and the hashing function appears to be used to provide an electronic signature (see col. 2, lines 23-46). The ticket of the reference has nothing at all to do with providing access to information *about* the commodity or service or event being accessed through use of an e ticket.

Accordingly, Sasmazel clearly does not teach or suggest the network electronic ticket as limited by the language of claims 38, 39, or 43. The Examiner also argues that Cogger discloses a web-based customer care in which a trouble ticket is used for allowing a customer to remotely access as service provider. In fact, Cogger appears to teach only that a “trouble ticket” is generated when a user requests a service (see passages cited in the Office actions). The “trouble ticket” of Cogger is not disclosed as providing “access” to a service, but is merely in response to a service request (see FIGs 5 and 12) and is nothing more than a way to track the progress of the

service (see Cogger Summary of the Invention). Nowhere is the Cogger trouble ticket suggested as being used to obtain *access* to a service, as the cited claims explicitly require.

Furthermore, no other reference of record suggests any network electronic ticket as claimed, and neither does the Examiner cite any of them for that purpose. Hence, the combination of references fails to teach all of the claim limitations, as required by MPEP §2143.03 (the combination of prior art reference(s) must teach or suggest *all* of the claim limitations for an obviousness rejection), and thus the claims are patentable over the references.

In addition, as argued in the previously filed response, claim 39 also recites a “mobile user terminal for communicating with the service server for purchasing the networked-linked electronic ticket,” an “information server for communicating with the mobile user terminal for checking the network electronic ticket before providing information to the mobile user terminal via the public network” (lines 16-19) and a

“gate terminal for communicating with the mobile user terminal and for automatically checking the electronic ticket before providing the customer access to the commodity, the service, and/or user admission to the event”

The Examiner has repeatedly failed to even *address* these claim limitations, despite being reminded of them in prior applicant responses, and applicant can find no teachings of any such features in the references of record, and thus claim 39 is patentable over the references for this reason as well.

Similarly, as also previously discussed in prior responses, claim 44 specifically recites “authentication information for authentication processing with the provider” and “authentication information for authentication processing when receiving the online information service.” These are separately claimed elements. None of the references suggest both of the authentication information elements as recited in the claim. Instead, the Examiner cites only a teaching for “authentication information for authentication processing with the provider” and has failed to show any teaching of “authentication information for authentication processing when receiving the online information service.” Thus, claim 44 is patentable over the references.

Claim 47 recites “reservation information which can be changed by the online information service.” The Examiner has failed to show that any of the references teach such reservation information that can be changed by an online information service. Thus, claim 47 is patentable over the references.

Furthermore, claim 48 recites a “a service server secret key for digital signature of the network-linked electronic ticket.” Hiroya and Sasamazel do not teach an electronic ticket having an secret key, and Cogger merely teaches about web-based customer service as discussed above. Accordingly, these claims are also patentable over the references.

Claim 52 recites "information service reception means" for performing the steps of:

authentication processing with the provider by using first authentication information which is contained in the network-linked electronic ticket;
accessing the provider by using identification information of the provider which is contained in the network-lined electronic ticket; and
performing authentication processing when receiving the online information service by using second authentication information which is included in the network-linked electronic ticket.

The cited references fail to suggest these limitations of the claim, and the Examiner has failed to even address the limitations of first authentication information and second authentication information. Thus, claim 52 is patentable over the references.

The remaining claims are patentable for at least one or more of the above reasons.

Finally, the Examiner has consistently failed to support a *prima facie* case of obviousness. In response to being challenged on this point in previous responses, the Examiner merely lists generalized conclusory benefits found in each of the references for practicing the teachings of that reference. This is hardly a *motivation* to combine one reference with another reference. Such an interpretation of motivation would make every reference *self-motivating*, because all references teach some benefit! This is clearly *not* legally sufficient.

For example, the Examiner states that it would be obvious to modify the Hiroya reference to add practices taught by the Sasmazel reference because “this would prevent a trouble on whether the electronic money and the electronic ticket are given or received actually (sic).” This statement is nothing more than a generalized summary of the benefits taught by Sasmazel.

Furthermore, the statement is not even related to the purpose of the network electronic ticket as recited in claim 38, which is to provide information about a commodity, service, or event that has been, is being, or will be accessed by the electronic ticket. There is nothing in this claim language that is related to preventing “trouble,” and thus, even if one were motivated for the reason discussed by the Examiner, one would not arrive at the *invention* (as claimed) by such

so-called motivation, because that motivation would not lead to any modification to provide *information* as is specifically claimed.

Likely recognizing this problem, the Examiner attempts to add an additional motivation for providing the online information discussed above. The Examiner states that Cogger discloses a Web based customer care in which a “trouble ticket or electronic ticket has been used for allowing a customer to remotely access a service provider” and concludes that it would have been “obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Hiroya and Sasmazel by including the limitation above as taught by Cogger because this would allow the customer to access and display the online information.”

But Cogger was not cited for teaching the network electronic ticket. Instead, Cogger teaches that a “trouble ticket” is generated when a user requests a service (see passages cited in the Office action). The “trouble ticket” is in response to a service request, but is *not* in response to an electronic ticket. See Figs. 5 and 12. The “trouble ticket” of Cogger is nothing more than a way to track the progress of the service request. It is not used to obtain access limited information about a commodity, service, or event that is accessed using an electronic ticket.

Accordingly, one skilled in the art would *not* be motivated to add the “trouble ticket” feature of Cogger to the other references, because none of the other references are concerned with tracking the *performance* of a service request, and Cogger is not concerned with using an electronic ticket for access to a service, commodity, or an event.

The Examiner also argues that the motivation does not need to be obtained from the reference, that instead the motivation can be provided by an “explanation based on logic and sound reasoning.” But the Examiner fails to provide any such explanation. Thus, there is no motivation for the combination.

For any combination of the above reasons, the claims are clearly patentable over the art of record.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32808.

Respectfully submitted,

PEARNE & GORDON LLP

By: 

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Date: December 1, 2005